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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/045,978 | 01/10/2002 | Monica M.A. Sanders | 60143P1 | 4861 |

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[REDACTED] EXAMINER

BELL, KENT L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1661 | 2 |

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | | |
|-----------------|--------------|--------------|---------|
| Application No. | 10/045,978 | Applicant(s) | SANDERS |
| Examiner | KENT L. BELL | Art Unit | 1661 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on application filed 1/10/02

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 1/10/02 is/are a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

4) Interview Summary (PTO-413) Paper No(s). _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: Rule 1.105 Requirement

Detailed Action

Objection to the Drawing

The submitted photographic illustration filed January 10, 2002 is objected to under 35 CFR 1.165(a). By way of explanation, the photographic illustration should not be mounted (37 CFR 1.84(e)).

The rules for submitting drawings, 37 CFR 1.84 and 37 CFR 1.165, were amended effective November 29, 2000. The USPTO delayed enforcement of these changes until October 1, 2001. Complete details can be found in the May 22, 2001 *Official Gazette* (1246 OG 106-107) or on the Internet at: <http://www.uspto.gov/web/offices/com/sol/og/2001/week21/patwavr.htm>.

Further, the drawings should not be sent to the 20231 zip code address for the United States Patent and Trademark Office. Please direct all replies to the United States Patent and Trademark Office via one of the following:

1. Hand carried directly to:
1911 South Clark Place
Crystal Mall One, 7th Floor Receptionist Area
Arlington, Virginia 22202

2. Mailed to:
U.S. Patent and Trademark Office
P.O. Box 2327
Arlington, Virginia 22202

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Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

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No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. The disclosure is objected to under 37 CFR 1.121(e) because the Latin name of the genus and species of the claimed plant and Variety Denomination of the claimed plant should be preceded by a heading as set forth in 37 CFR 1.163(c)(4)(5) and 37 CFR 1.163(d). This information should be set forth before the "**Background of the new plant**" section as set forth in 37 CFR 1.163(c).

B. Page 1, line 11, and page 2, line 9, Applicant is requested to set forth in the specification whether the cultivars 'Southern Cross' and 'R116' have been patented in the United States, is currently the subject of a pending U.S. Plant Patent application, or unpatented. If patented, --(U.S. Plant Patent No.)-- should be inserted after the cultivar name. If the subject of a

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pending application, such should be referred to by serial number. If unpatented, --(unpatented)-- should be inserted after the appropriate cultivar name.

C. Page 1, lines 16 and 17, Applicant states the instant plant's characteristics "appear" to be fixed. The recitation "appear" causes confusion. In order to obtain a U.S. Plant Patent the instant plant has to reproduce true to type in successive generations of asexual reproduction. Either the plant reproduces true or it doesn't.

If the instant plant does reproduce true to type then it is suggested that applicant delete the recitation "It has been found to retain its distinctive characteristics through successive propagations, and this novelty appears to be firmly fixed." and insert in its place --The distinctive characteristics of this new Ageratum are stable and reproduced true to type in successive generations of asexual reproduction.--.

If the instant plant does not reproduce true to type then the instant plant would be one of many plants reproduced through successive generations. Applicant would not be able to obtain a U.S. Plant Patent on the instant plant, 'Agetis'.

D. Page 2, after line 8, before line 9, Applicant should state either --Table A-- or --Table 1-- since the information set forth at 9 is a Table.

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E. Page 2, line 9, Applicant states the instant plant's flower color is "Blue". When compared to the photographic illustration provided, the instant plant's flower color is not "Blue". Correction and/or clarification is necessary.

F. Applicant should set forth in the specification the time it takes to produce a finished plant.

G. Page 3, lines 5-12, Applicant should set forth in the specification additional information relative to the instant plant's stem including the typical and observed stem length.

H. Page 3, line 16, Applicant states the leaf blade shape is "Cordate". The term cordate typically describes the base of a leaf. When compared to the photographic illustration provided it appears the instant plant's leaves are --Ovate--. Applicant should review the leaf shape and set forth in the specification a proper leaf shape descriptor.

I. Page 3, line 28 to page 4, line 2, Applicant should set forth in the specification additional information relative to the instant plant's petiole including the typical and observed petiole diameter, if available.

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J. Page 4, lines 6-10, Applicant should set forth in the specification additional information relative to the instant plant's peduncle and pedicel including the typical and observed peduncle and pedicel diameter.

K. Applicant should set forth in the specification additional information relative to the instant plant's inflorescence including the typical and observed umbel diameter and depth, capitulum depth, and number of inflorescences per plant.

L. Page 4, line 12, Applicant should set forth in the specification additional information relative to the instant plant's disc florets including the typical and observed disc diameter, disc floret shape, length and diameter, and coloration with reference to the employed color chart.

M. Page 4, lines 13-15, Applicant sets forth information relative to the instant plant's bracts (phyllaries). Applicant states "bracts", however, a more correct botanical term for this characteristic is "phyllary". Applicant should change "bracts" to --phyllaries--.

N. Page 4, lines 13-15, Applicant should set forth in the specification additional information relative to the instant plant's phyllaries including the typical and observed phyllary diameter.

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O. Page 4, line 15, Applicant sets forth in the specification a color designation for the phyllaries. However, it is uncertain if the coloration provided is for the upper, lower, or both surfaces. Applicant should set forth in the specification a color designation(s) for the upper and lower surfaces of the phyllaries with reference to the employed color chart.

P. The instant plant's inflorescence is a composite. Typically composites are made up of ray and disc florets. As such, if produced, applicant should set forth in the specification information relative to the instant plant's ray florets including the typical and observed ray floret number per bloom, shape, length, diameter, and coloration (both surfaces) with reference to the employed color chart.

Q. Page 4, lines 23 and 24, Applicant sets forth information relative to the instant plant's stigma and style. However, applicant has not described any other reproductive organ and has not stated where the Androecium and Gynoecium are present, i.e. Typically, Androecium is present on both ray and disc florets and Gynoecium is present on ray florets only.

Applicant should provide additional information relative to the instant plant's reproductive organs including pistil number, anthers, stigma, styles, ovary/ies, (such as quantity, size and coloration or organs) into the specification with reference to the color chart employed (if

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available). If pollen is produced, such should be accounted for in general terms relative to the quantity and in coloration by way of reference to the color chart employed.

R. Applicant should set forth in the specification information relative to the instant plant's inflorescence bud including the typical and observed bud shape, length, diameter, and coloration with reference to the employed color chart.

The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Claim Rejection

35 U.S.C. 112, 1st & 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

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Potential Issue Under 35 U.S.C. 102

The claimed Ageratum variety 'Agetis' is described in Breeder's Right application number 20001592 filed in The European Community on October 27, 2000 and published on December 15, 2000. The published application is a "printed publication" under 35 U.S.C. 102 because it is accessible to persons concerned with the art to which the documents relate. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128. For example, UPOV publishes the application number, date of publication, species of plant and variety denomination for PBR certificates, and copies of the European application, 20001592, are obtainable through the European Communities Register of Applications for Community Plant Variety Rights. This register is open to public inspection and the information in this register is published every two months. Thus information regarding the claimed variety, in the form of the publication noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ 2d 1618, 1620, (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to

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a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.”).

While the publication cited above discloses the claimed plant variety, a question remains as to whether the reference is enabling. If the plant was publicly available, then the application, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. The ability of the Office to determine whether the claimed plant was publicly available is limited. Search of electronic databases, the internet and the Office's collection of retail catalogs has not revealed any evidence that the claimed plant was on sale anywhere in the world. However, the Office's collection of retail catalogs is not comprehensive. Furthermore, the claimed plant may have been sold at the wholesale level, sold under a different name, or even distributed to interested parties free of charge. Since the inventor and assignee of the instant application are in a better position to know when, if ever, the claimed plant was made publicly available, the Examiner is requiring this information in the attached Requirement for Information Under 37 CFR 1.105.

This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

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Comments

Due to the amount of revision seen necessary in this application, it is suggested that Applicant file a substitute specification, incorporating all additions, deletions and modifications so as to provide the printer a clean copy at the time of allowance. Applicant should specifically authorize cancellation of the present specification to the same. Further, a clean copy and marked up copy (showing any addition, deletion, and/or modification) of the substitute specification should be submitted.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (703) 306-3224. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205.

The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

KENT BELL
PRIMARY EXAMINER

Kent L. Bell

Detailed Action

REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined reasonably necessary to the examination of this application.

The information is required to determine when, if ever, the claimed plant variety, 'Agetis', was publicly available prior to the filing date of the instant application.

In response to this requirement please provide any information available regarding the sale or other public distribution of the claimed plant variety anywhere in the world, including the date(s) of any sale or other public distribution. Also, please provide copies of the published European Community application, 20001592. The Office does not maintain a collection of Breeders' Rights documents and they are not readily obtainable electronically. It is reasonable to expect that Applicant can readily obtain the requested document(s) and information.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

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Applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is three months.